

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/082,874 Confirmation No. 4966  
Applicant : T. Diez  
Filed : 02/26/2002  
TC/A.U. : 2655  
Examiner : H. X. Vo  
Docket No. : 02-171  
Customer No. : 34704  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

Reasons for Pre-Appeal Brief Request for Review

Dear Sir:

This paper is submitted accompanying a Pre-Appeal Brief Request for Review.

In the action from which appeal is taken, the Examiner finally rejected claims 15-17 and 22 as anticipated by Tamura (JP 4327748), rejected claims 1-4, 7-8, 10 and 24-25 as obvious based upon Tamura and an ESI Engineering Publication Bush et al. (US 6397186), and rejected claims 5-6, 9 and 11-14 as obvious based upon Tamura, the ESI Publication, and Bush et al. (US 6,397,186).

Starting with claim 1, it is respectfully submitted that the Examiner is not giving proper weight to the fact that claim 1 calls for positioning the control module outside a specific noise zone where noise from the component is greater than 60 db A. In order to reject a claim under 35 USC 103, as the Examiner has done, the Examiner must establish a *prima facie* case that all elements of the claim are taught by some combination of the art. The Examiner has relied upon Tamura in view of ESI in rejecting claim 1. A person of ordinary skill in the art

reviewing Tamura would find no teaching whatsoever for positioning the a control module in any location with respect to the HVAC component. Further, ESI is drawn to noise control for HVAC equipment. Thus, the teachings in this document are drawn to ways of controlling noise, not adapting to it as is done by the present invention.

In finding claim 1 obvious, the Examiner correlates the specific and clear limitations of claim 1 with an assumption that the components in Tamura are "far apart", and supports his initial assumption stating that "it is well known that the HVAC device is placed on the outside of the building". Respectfully, it is pointed out that in most cases where the user is provided with a remote control device, the unit in question is a window mounted unit, and will very frequently be in the same room and potentially very close to the typical location of the user.

This line of point and counterpoint, debating whether the components in Tamura are "far" or "near", could of course continue, primarily because the prior art itself is absolutely silent on this point. However, in the total absence of any teaching in the prior art, the rejection is based upon mere speculation by the Examiner, which does not provide the basis for a sound rejection under 35 USC 103.

It is again pointed out that claim 1 calls for location of the control module outside of a specifically identified noise zone. Tamura is silent on the entire point, and ESI teaches nothing more than that machinery makes noise.

Reconsideration and favorable treatment of claim 1 are appropriate and respectfully requested.

Turning to independent claim 15, the Examiner has again missed or ignored a key point of this claim. Claim 15 calls for the system to have an indicator member for identifying a received speech command, and also for that indicator member to be a speech simulator. Thus, claim 15 calls for a system wherein a speech simulator generates an indicator that a command has been recognized. A fine but important distinction in Tamura is that Tamura teaches that a visual signal is given when a voice command is received. A proper rejection under 35 USC 102 requires that each and every element of the claim be taught in the single prior art reference. In the present instance, this is clearly not the case. As set forth previously, a speech indicator that a command has been received is of value, for example to sight impaired users, and this subject matter is not at all disclosed or taught by Tamura. Reconsideration and favorable treatment of claim 15 is appropriate and respectfully requested.

Method claim 25 calls for the subject matter of claim 1 in method steps, and this subject matter is also clearly not at all taught by Tamura or any other art of record. Allowance of claim 25 is respectfully solicited.

This paper is accompanied by authorization to charge a deposit account for an extension of time and the fee for filing a Notice of Appeal. It is believed that no additional fee is due. If any such fee is due, please charge same to deposit account no. 02-0184.

Respectfully submitted,  
Tomas Diez et al.

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November 19, 2007

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  02-171
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First Named Inventor  Diez et al.		
Art Unit  2626	Examiner  Vo, Huyen X.	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

<input type="checkbox"/> applicant/inventor.	/george a. coury/ Signature
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	George A. Coury Typed or printed name
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 34,309	203-777-6628 Telephone number
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	November 19, 2007 Date

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